

The objection to the drawings, frankly, is not understood. Figure 1 and Figure 2 are intended to show the control panel 25 in a recess in arm 18 (see Figure 1, as amended, in Amendment A). And, control button 35 in Figure 4 was amended in Amendment A to a "on/off" button. Conformed copies of amended Figures 1 and 4 with the previously entered changes highlighted are enclosed for the convenience of the Examiner.

Turning to the art rejections, the Examiner acknowledges the primary reference, Jain, teaches a chair without a light source, but takes the position that this missing teaching is provided by Moceri stating, "A skilled artisan could have readily appreciated that Jain's chair could be included with a light source in view of Moceri's teaching". The Examiner's conclusion clearly is based on application of impermissible hindsight.

Lights and particular light bulb filaments are intrinsically fragile. Given the intrinsic fragility of light bulb filaments, it is submitted one skilled in the art would not think to combine a light and massager since vibrations from the massager likely would be expected to dislodge or break the light filaments and render the light inoperative. Moceri does not have the problem of vibration, since Moceri does not teach massage motors.

In finally rejecting Applicants' claims as obvious from the art, the Examiner takes the position, "Applicant cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references". It is submitted the Examiner has cherry-picked individual teachings from the prior art and combined same using Applicants' specification as a blueprint, all the while ignoring well-known characteristics of light filaments that would prejudice one skilled in the art to making the combination proposed.

HAYES SOLOWAY P.C.  
130 W. CUSHING ST.  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

As pointed out by the Board of Patent Appeals and Interferences in the unpublished Decision in Appeal No. 1999-2401<sup>2</sup>:

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972)....

....Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l, Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In our view, the only suggestion for modifying the applied prior art in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that

<sup>2</sup> While the Appeal Decision was not published for opposition, and therefore not binding precedent of the Board, the Decisions relied upon by the Board, and the Board's application thereof, as discussed above, do constitute binding precedent.

we cannot sustain the examiner's rejections of [the] claims...."  
(emphasis in original).

It is submitted the Examiner has employed impermissible hindsight and has applied the teachings of the present invention to make out an obviousness rejection in this case.

In the meanwhile, third party infringements by Igia (already of record), and more recently by SPI and Frontgate (see Exhibits A and B), and numerous retailers, remain unabated.

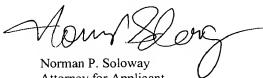
Aside from the above, Applicants reiterate and incorporate by reference their previous discussion of the several art rejections as set forth in Amendment A. Further discussion of the art rejections are being reserved for Applicants' Appeal Brief.

A Notice of Appeal accompanies this amendment.

Form PTO-2038 authorizing a charge in the amount of \$320.00 to cover the Notice of Appeal fee accompanies this amendment.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account No. 08-1391.

Respectfully submitted,



Norman P. Soloway  
Attorney for Applicant  
Reg. No. 24,315

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on January 14, 2003, at Tucson, Arizona.

By Diana Carr

NPS:dc

MARKED AMENDED CLAIMS

SERIAL NO. 09/801,353

DOCKET: BROOKSTONE 00.04



**MARKED CLAIMS SHOWING CHANGES MADE:**

11. (Amended) The cushion of claim 10, further comprising a controller for [adjusting] altering the on/off status of the massage motors.

35. (Twice Amended) The massaging bed rest cushion of claim 34, wherein the control panel comprises at least one switch for altering the on/off status of the light, the switch being covered by a flexible membrane.

50. (Amended) A massaging bed rest cushion for supporting a person in a sitting position, comprising:

a back portion comprising a contoured forward surface and a rear surface, the surfaces separated by a padded interior;

a plurality of massage motors enclosed between the forward surface and the rear surface;

a light source mounted to the back portion for providing light for a user;

a heater enclosed within the cushion; and

a controller for [adjusting] altering the on/off status of the massage motors.

51. (Amended) A massaging bed rest cushion for supporting a person in a sitting position, comprising:

a back portion comprising a contoured forward surface and a rear surface, the surfaces separated by a padded interior;

a plurality of massage motors enclosed between the forward surface and the rear surface;

a light source mounted to the back portion for providing light for a user;

a controller for [adjusting] altering the on/off status of the massage motors; and

an on/off device on the controller for altering on/off status of the light source.

**HIGH-LIGHTED MARKED DRAWINGS FROM  
AMENDMENT A**

**SERIAL NO. 09/801,353**

**DOCKET: BROOKSTONE 00.04**



Amended per A

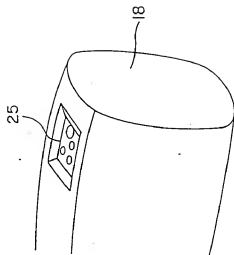


FIG. 2

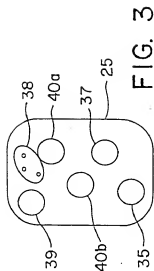


FIG. 3

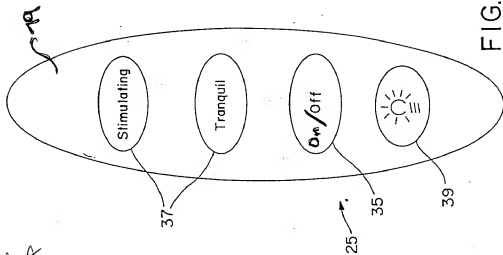


FIG. 4

Amended per A



